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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/545,111 04/06/00 ANTONIOUS

A ADA-119

EXAMINER

021884 QM32/0531
WELSH & FLAXMAN LLC
2341 JEFFERSON DAVIS HIGHWAY
SUITE 112
ARLINGTON VA 22202

PASSANITI, S

ART UNIT

PAPER NUMBER

3711
DATE MAILED:

05/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.
09/545,111

Applicant(s)
ANTONIOUS

Examiner
SEBASTIANO PASSANITI

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— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Mar 9, 2001

2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-41 and 52-61 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-41 and 52-61 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

Sebastiano Passaniti
Primary Examiner

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This Office action is responsive to communication received 03/09/2001 - Amendment B.

Claims 42-51 have been canceled, as directed.

Claims 1-41 and 52-61 remain pending.

Following is an action on the MERITS:

At the outset, it is noted that the amendment to newly presented claim 61 is improper. No bracketed words should appear in the claims. See 37 CFR 1.173(b)(2) and (d), a copy of which is attached to this Office action. However, in an effort to further the prosecution of this application in a timely fashion, the claims have been considered on their merits. Applicant is respectfully requested to provide a corrected amendment that addresses the additional language presented by new claim 61.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed. A further explanation follows below under "RESPONSE TO ARGUMENTS".

Claims 1-41 and 52-61 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

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The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

Claims 52-61 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Specifically, as to newly presented claims 52 and 57, the insert is no longer referred to as a unitary insert, nor is the insert detailed as being at least as rigid as the tubular section, nor is the insert described as being shorter than the tubular section. A review of the original application for the patent shows that the specific term "unitary" and specific phrases "at least as rigid as the tubular section" and "shorter than the tubular section" were part of the

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language added to the claims and argued by the applicant to specifically overcome the rejections of the original claims and to place the claims in condition for allowance.

Claims 1-41 and 52-61 appear to be allowable over the prior art references of record.

RESPONSE TO ARGUMENTS

In the arguments received 03/09/2001, the applicant presents a number of comments regarding all of 1) the reissue oath/declaration submitted in an amendment filed February 05, 2001, 2) the addition of new claims 52-61 along with the cancellation of claims 42-51 and an amendment to the specification to place the specification of the present reissue application in conformance with the specification of the patent as issued, 3) an acknowledgment of the need to locate the original patent or file an appropriate affidavit or declaration if the original patent is not located, 4) the applicant's disagreement with the rejection of the claims under 35 U.S.C. §251 as being an improper recapture of broadened subject matter, 5) a variety of arguments in support of patentable subject matter presented in new claims 52-61 in view of the prior art of record, and 6) a query regarding the status of claims 43 and 48, allegedly missing in any citation in a previous Office action.

In response to these arguments, the following observations and/or arguments are presented:

With respect to item (1) above, acknowledgment is made of the declaration received 02/02/2001. Applicant's attention is directed to M.P.E.P. §1444, which states:

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“During the prosecution of a reissue application, amendments are often made and additional errors in the patent are corrected. A supplemental oath/declaration need not be submitted with each amendment and additional correction. Rather, it is suggested that the reissue applicant wait until the case is in condition for allowance, and then submit a cumulative supplemental reissue oath/declaration pursuant to 37 CFR 1.175(b)(1). See MPEP §1414.01 for a discussion of the required content of a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1).

A supplemental oath/declaration under 37 CFR 1.175(b)(1) must be submitted before allowance. It may be submitted with any reply prior to allowance. It may be submitted to overcome a rejection under 35 U.S.C 251 made by the examiner, where it is indicated that the submission of the supplemental oath/declaration will overcome the rejection.

A supplemental oath/declaration under 37 CFR 1.175(b)(1) will be required where:

- (A) the application is otherwise (other than the need for this supplemental oath/declaration) in condition for allowance;
- (B) amendments or other corrections of errors in the patent have been made subsequent to the last oath/declaration filed in the application; and
- (C) at least one of the amendments or other corrections corrects an error under 35 U.S.C. 251.

When a supplemental oath/declaration under 37 CFR 1.175(b)(1) directed to the amendments or other corrections of error is required, the examiner is encouraged to telephone the applicant and request the submission of the supplemental oath/declaration by fax. If the circumstances do not permit making a telephone call, or if applicant declines or is unable to promptly submit the oath/declaration, the examiner should issue a final Office action (final rejection) and use form paragraph 14.05.02.”

It is noted, however, that a supplemental reissue oath/declaration will be necessary prior to allowance. Note the comments, *supra*.

As to item (2) above, newly submitted claims 52-61 have been entered, notwithstanding the fact that a minor informality exists in newly presented claim 61.

Applicant’s cooperation is respectfully requested to address this issue, as noted *supra*.

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Considering item (3) above, the requirement for filing the original patent or an affidavit or declaration attesting to its loss or unavailability is repeated in this Office action (above) for the convenience of the applicant.

Pertinent to item (4) above, applicant's arguments regarding the recapture issues in this reissue application have been considered, but are not deemed to be persuasive.

Applicant's attention is directed to MPEP §1412.02, wherein it is noted that:

"Reissue claims that are broader in certain aspects and narrower in others vis-a-vis claims canceled from the original application to obtain a patent may avoid the effect of the recapture rule if the claims are broader in a way that does not attempt to reclaim what was surrendered earlier. *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 994, 27 USPQ2d 1521, 1525 (Fed. Cir. 1993). "[I]f the reissue claim is as broad as or broader in an aspect germane to a prior art rejection, but narrower in another aspect completely unrelated to the rejection, the recapture rule bars the claim; [] if the reissue claim is narrower in an aspect germane to [a] prior art rejection, and broader in an aspect unrelated to the rejection, the recapture rule does not bar the claim, but other rejections are possible." *Clement*, 131 F.3d at 1470, 45 USPQ2d at 1165.

If the broadening aspect of the reissue claim relates to subject matter previously surrendered, the examiner must determine whether the newly added narrowing limitation in the reissue claim modifies the claim such that the scope of the claim no longer results in a recapture of the surrendered subject matter. If the narrowing limitation modifies the claim in such a manner that the scope of the claim no longer results in a recapture of the surrendered subject matter, then there is no recapture. In this situation, even though a rejection based on recapture is not made, the examiner should make of record the reason(s) why, as a result of the narrowing limitation, there is no recapture."

In this case, applicant's narrowing limitations added to, for example, claims 52 and 57, and including details about the significance of an insert secured at the distal end of the shaft for enhancing swing control, stiffness and flex control, shock absorption and vibration elimination or reduction, is **not** at all related to the earlier patented limitations calling for

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“unitary” , “at least as rigid as the tubular section” and “shorter than the tubular section” elements and the manner in which these phrases defined over the art. Since the narrowing is **not** related to the prior art rejection and **not** related to the subject matter surrendered in the original patent application, recapture exists and the claims are justly rejected under 35 U.S.C. §251.

Concerning item (5) above, in view of the indicated allowability of the claims over the prior art of record, no further comments are deemed necessary here.

In discussing item (6), it is noted that the previous action, mailed 11/03/2000 makes reference to claims 43 and 48 on page 6, line 11 of the Office action. The inadvertent omission of the notation of claims 43 and 48 on page 6, line 1 of the rejection statement is sincerely regretted. In view of applicant’s canceling of claims 43 and 48 as part of the 03/09/2001 amendment, no further comments are deemed necessary here.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is (703)308-1006.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeanette Chapman, can be reached on (703) 308-1310. The formal fax phone number for the organization where this application or proceeding is assigned is (703) 305-3579. The informal fax phone number is (703) 308-7768. Applicant is strongly urged to contact or leave voice mail notification with the examiner just prior to sending an informal facsimile transmission.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Applicant may find it useful to refer to the Official Web site for the United States Patent & Trademark Office at www.uspto.gov for information regarding a variety of patent and trademark related topics.

Sebastiano Passaniti/ sp
May 29, 2001


SEBASTIANO PASSANITI
PRIMARY EXAMINER
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Amendments to the specification

may only be made as set forth in 37 CFR 1.173(b)(1), as follows:

- a. An entire paragraph may be deleted by a statement requesting/directing the deletion of a specified paragraph without presentation of the text of such paragraph. 37 CFR 1.173(b)(1).
- b. Any change in the specification (other than (a) above) must be presented as an entire paragraph (when proposed by the applicant). The precise point in the specification must be indicated where the amended paragraph is to be located. 37 CFR 1.173(b)(1). All subject matter being added to the patent **must be underlined**. All subject matter being deleted from the patent **must be placed between brackets**. 37 CFR 1.173(d). Examiner's Amendment exceptions as set out in revised 37 CFR 1.121(g) apply in reissue applications. See MPEP 1453.

Amendments to the claims

may only be made as set forth in 37 CFR 1.173(b)(2), as follows:

- a. Original patent claims **must not** be renumbered. 37 CFR 1.173(e).
- b. Claims added to the patent **must** follow the number of the highest numbered patent claim (37 CFR 1.173(e)) and **must** be underlined in their entirety (37 CFR 1.173(d)).
- c. A claim (original or new) may be deleted by a statement requesting the deletion of a specified claim without presentation of the text of such claim. 37 CFR 1.173(b)(2).
- d. Any change to the text of a claim (original or new) must be presented as an entire numbered claim (whether proposed by the applicant or made by the examiner in an Examiner's Amendment). All subject matter being added to an original patent claim **must be underlined**. All subject matter being deleted from an original patent claim **must be placed between brackets**. 37 CFR 1.173(b)(2) and (d). Subject matter being added to a new claim requires rewriting (and underlining) of the entire new claim.
- e. If a claim is amended during reissue prosecution, a parenthetical expression "(amended)," "(twice amended)," etc., should follow the original claim number. 37 CFR 1.173(b)(2). Alternatively, applicant may effectively re-write a claim by presenting it as a new (fully underlined) claim with a new claim number, and canceling the old claim. Brackets and underlining are to be used to reflect only those changes in the text from the original patented text and not from any previous amendment in the reissue application. § 1.173(g).
- f. Each amendment submission must set forth the status of all patent claims and of all added claims (i.e., "pending" or "canceled") as of the date of the amendment. 37 CFR 1.173(c).
- g. Each amendatory change, when first submitted, must be accompanied by an explanation of the support in the disclosure of the patent for the change (along with any additional comments) on page(s) separate from the page(s) containing the amendment. 37 CFR 1.173(c).

Amendments to the drawing (37 CFR 1.173(b)(3))

- a. Amendments to the original patent drawings are not permitted. 37 CFR 1.173(b)(3).
- b. Any changes to the patent drawings must be made by way of a new sheet of drawings with the amended figures identified as "amended" and with added figures identified as "new" for each sheet of drawings changed, as required by 37 CFR 1.84. 37 CFR 1.173(b)(3).
- c. Where a change to the drawings is desired, a separate paper must be filed and it should include a sketch showing the proposed changes in red. If the examiner approves the proposed changes, the new drawing sheets, including the changes, should be submitted. 37 CFR 1.173(b)(3).